

REMARKS/ARGUMENTS

This Amendment is submitted in response to the Office Action mailed on March 2, 2004. In the Office Action, claims 1, 3-14, 16-18, 20, 21, 23, 24, and 27-34 were rejected under 35 U.S.C. § 103(a) over U. S. Patent No. 5,499,842 issued to Yamamoto *et al.* (herein "Yamamoto") in view of U. S. Patent No. 6,453,535 issued to Nicholas (herein "Nicholas"). By this paper, claims 21 and 30 have been amended and a copy of the Declaration of Edward Friery (herein "Declaration") has been attached hereto as Exhibit 1. In view of these changes and the following remarks, reconsideration and allowance of all of the pending claims is respectfully requested.

AMENDMENT OF CLAIMS 21 AND 20

The present paper has amended claims 21 and 30 to improve the form of these claims. These changes are non-limiting amendments that do not, in any way, affect the scope of the present claims.

REJECTION OF CLAIMS 1, 3-14, 16-18, 20, 21, 23, 24, AND 27-34 UNDER 35 U.S.C. § 103(a)

As outlined above, the Office Action rejected claims 1, 3-14, 16-18, 20, 21, 23, 24, and 27-34 under § 103(a) over Yamamoto in view of Nicholas. The Applicants respectfully traverse this rejection.

A. A *Prima Facie* Case of Obviousness Has Not Been Made.

It is well settled that the PTO has the burden to establish a *prima facie* case of obviousness. MPEP §2142. "If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." *Id.* Moreover, in considering whether a *prima facie* case has been established, evidence that the cited references teach away from their combination or that the art teaches away from the Applicants' invention defeats, by itself, any assertion of *prima facie* obviousness. *See e.g., Winner International Royalty Corp. v.*

Wang, 53 USPQ2d 1580, 1587 (Fed. Cir. 2000); *In re Grasselli*, 218 USPQ 769, 779 (Fed. Cir. 1983); *In re Fine*, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988); MPEP § 2146.

1. Yamamoto and Nicholas Teach Away From Their Combination

In the present case, the Examiner asserts that it would have been obvious to place the outer layer 20 taught by Nicholas over the top of Yamamoto's outer wall 11 to arrive at the claimed invention. *See, e.g.*, Office Action 2-3. Even if it assumed that such a modification of Yamamoto would arrive at the claimed invention, this modification of Yamamoto is improper because Yamamoto contradicts and directly teaches away from using any sort of additional layer over the top of the outer wall 11. *See, e.g.*, *Winner International*, 53 USPQ2d at 1587 (holding that if the references teach away from the proposed modification, then the proposed modification is not obvious).

Specifically, Yamamoto's system comprises a pad 10 that is used to cover and mount an airbag onto a vehicle. Yamamoto, Col. 1, lines 5-10. This pad 10 includes a single outer wall 11 that has a decorative mark 11a on the front of the wall 11 and a seam 15 formed in a rear surface of the outer wall 11. (*See Figures 1 and 2, Col. 4, lines 8-10, and Col. 5, lines 52-64 of Yamamoto.*) The decorative mark 11a is within the view of a vehicle occupant and is designed to increase the overall visual appearance and aesthetics of the vehicle interior. Thus, by including the decorative mark 11a on the outer wall 11, Yamamoto teaches that the outer wall 11 is the outermost layer of the pad 10 that is viewable by the occupant. Such teaching contradicts and *teaches away* from using the extra layer of material taught by Nicholas as a means of covering the outer wall 11 because if such a combination were made, the outer layer 11 would no longer be the outermost layer, nor would the decorative mark 11a be visible to the vehicle occupant.

Thus, because Yamamoto directly teaches away from a combination with Nicholas, the present claims cannot be considered *prima facie* obvious in light of these references. Withdrawal of this rejection is respectfully requested.

2. Knowledge and Beliefs In the Industry Taught Away From the Applicant's Invention

Furthermore, in addition to having the references teach away from their combination, the known teachings in the art taught away from the Applicant's invention. Teaching away from an applicant's invention demonstrates a lack of *prima facie* obviousness. *McGinley v. Franklin Sports*, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001); *In re Fine*, 5 USPQ2d at 1599. In particular, teaching "in a direction divergent from the path that was taken by the applicant" demonstrates nonobviousness. *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 52 USPQ2d 1294, 1298 (Fed. Cir. 1999).

As will be explained in greater detail below, at the time the Applicants made their invention, it was widely believed in the industry that a nonlinear seam would permit cover to tear outside the seam, leading to unpredictable cushion positioning during deployment. *See Declaration*, ¶ 10 (attached as Exhibit 1). Such teachings and beliefs within the industry contradicted and direct taught away from the Applicants' use of nonlinear seams as a mechanism for providing predictable cushion positioning during deployment. Such teaching away from the Applicants' invention demonstrates nonobviousness and defeats, by itself, any assertion that the Examiner has established a *prima facie* case of obviousness.

B. Even If It Is Assumed That The Examiner Can Establish A *Prima Facie* Case, Objective or Secondary Considerations Of Nonobviousness Show That The Present Claims Are Allowable.

Furthermore, even if it is assumed that the Examiner can establish a *prima facie* case of obviousness, the secondary considerations and objective evidence in the present case clearly indicates that the present claims should not be rejected under § 103(a). As noted by the courts, objective considerations of nonobviousness, such as a long-felt need and skepticism of those skilled in the art, are highly relevant to a determination of obviousness. *See, e.g., Graham v. John Deere*, 148 USPQ 459 (1966) and MPEP §§ 716.04 and 716.05. In fact, the Federal Circuit has observed:

Indeed, the evidence of secondary considerations may often be the *most probative and cogent evidence* in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not. It is to be considered as part of all evidence, not just when the decision maker remains in doubt after reviewing the art.

Stratoflex, Inc. v. Aeroquip. Corp., 218 U.S.P.Q. 871, 879 (Fed. Cir. 1983). Even at the examination stage, the secondary factors must be considered. *See, e.g., In re Sernaker*, 217 U.S.P.Q. 1, 7 (Fed. Cir. 1983) ("If . . . a patent application properly presents evidence relating to the secondary considerations, the Board must always consider such evidence in connection with the determination of obviousness.").

In this case, there has been a long-felt and persistent need for the invention claimed in the present application, as shown in the attached Declaration. For at least seven and a half years, the need to prevent or limit the visibility of tear seam for an airbag has been recognized in the industry. Declaration, ¶ 6. This problem is frequently referred to in the industry as the seam "read-through" problem. Declaration, ¶ 3. Mr. Friery, one of the co-inventors of the invention disclosed in the present application, was hired more than seven and half years ago by a predecessor of Autoliv ASP, Inc. ("Autoliv"), (the assignee of this Application, to resolve this and other problems related to airbag covers. Declaration, ¶ 6. Mr. Friery has worked on this problem for more than five years. Declaration, ¶ 6. In addition, Mr. Friery continues to receive calls from other employees of Autoliv and its foreign affiliates who seek a resolution to this problem. Declaration, ¶ 13. Thus, there is a persistent and long-felt need to successfully resolve the seam-read through problem.

Other solutions have been proposed, but none have provided a satisfactory resolution of this problem. For instance, placing a styling line over the seam has been proposed. Declaration, ¶ 7. However, just like the indentation created by the seam, this styling line disrupts the style scheme of the interior of the vehicle. Declaration, ¶ 7. This proposed solution thus perpetuates, but does not resolve the problem. Declaration, ¶ 7.

The invention of the present Application resolves the seam read-through problem. Testing has shown that the use of a quality outer layer that is sufficiently stiff with an underlying nonlinear seam eliminates the seam read-through problem. Declaration, ¶¶ 8, 11. Using the

present invention, only by pressing the outer layer with a great deal of force is a portion of the seam visible. Declaration, ¶ 11. Furthermore, the seam is no longer visible when the outer layer returns to its normal position. Declaration, ¶ 11.

In addition, the present invention was greeted with skepticism by those skilled in the art. "Expressions of disbelief by experts constitute strong evidence of nonobviousness." *Environmental Designs, Ltd. v. Union Oil Co. of Cal.* 281 U.S.P.Q. 865, 869 (Fed. Cir. 1983); *see also* MPEP § 716.05.

Linear seams are the standard in the industry. Those in the industry believed that, during deployment, a cover with a nonlinear seam would tear outside the seam such that the inflatable cushion would deploy in an unpredictable manner, not providing proper protection to the occupant. Declaration, ¶ 10. Even Mr. Friery's supervisor at the time, who was a highly experienced and very capable engineer, believed that this would be the case. Declaration, ¶ 10. However, testing has shown that this is not so. Declaration, ¶ 10. The present invention both conceals the tear seam and does not interfere with proper deployment of the inflatable cushion. Declaration, ¶¶ 10, 11.

Accordingly, the objective considerations provide strong evidence that the present invention is not obvious, but, in fact, runs contrary to conventional teachings in the field and satisfies a long-felt need in the industry.

CONCLUSION

In view of the foregoing, the Applicants submit that none of the pending claims can be rejected as obvious to the cited references under § 103(a). Accordingly, the Applicants request that the present claims be immediately allowed. However, if there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Appl. No. 09/677,058
Amdt. dated July 2, 2004
Reply to Office Action of March 2, 2004

Respectfully submitted,



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